

REMARKS

With entry of this amendment, claims 14 and 19 have been cancelled. As a result, claims 1-13, 15-18, and 20-47 are pending in this application. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Rejections-35 U.S.C. §102

Claims 1-5, 7, 9-13, 15-17, and 23 stand rejected under 35 U.S.C. §102(b), as being anticipated by DE 2,124,684 (“Stadlmayr”). Applicant respectfully traverses this rejection, since Stadlmayr does not disclose each and every element required by these claims, as amended.

In particular, claim 1 has been amended to require that the other electrode element be an array comprising a plurality of electrodes that assume an outwardly straight shape when radially extended from the elongated member. Notably, a similar limitation recited in claim 19 was found by the Examiner to be missing in Stadlmayr.

Claim 10 has been amended to incorporate the limitations of claim 14, which the Examiner found to recite patentable subject matter.

Thus, Applicant submits that independent claims 1 and 10, as well as the claimed depending therefrom (claims 2-5, 7, 9, 11, 17, and 23).

Claim Rejections-35 U.S.C. §103

Claims 1-5, 7, 9-13, 15-17, 23, 25-30, 32, 34-39, and 41-46 stand rejected under 35 U.S.C. §102(b) or 35 U.S.C. §103(a) as being anticipated by, or in the alternative, obvious over, U.S. Patent Publication No. 2002/0022864 (“Mahvi”). Applicant respectfully traverses

these rejections, since Mahvi does not disclose, teach, or suggest the combination of elements required by these claims.

As stated above, independent claims 1 and 10 have been amended to require the other electrode element or array to have electrodes that assume an outwardly straight shape when extended or deployed, which is not disclosed in Mahvi.

Independent claim 25 requires “a controller for configuring the two electrode elements and other electrode element as two bipolar electrode pairs, wherein the other electrode element is common to the bipolar electrode pairs.” There is no disclosure in Mahvi that the controller 56 is capable of performing this function. Citing Figure 7 and claims 7 and 20 of Mahvi, the Examiner has stated that Mahvi intends to use the third or common electrode to control the flow of current from the first and second electrodes.

However, the accompanying text of Figure 7 merely discloses that the electrodes 22a-22c are electrically isolated from each other, and that a phase difference can be employed between the separate feeds 53 to control the current flow between the electrode wires 32 (see paragraph [0061]). Claims 17 and 20 of Mahvi merely recites that a power supply is connected to three electrodes to independently control current flow at two of the electrodes. Thus, not only does Mahvi fail disclose that the third electrode is connected to the first electrode to form a first bipolar electrode pair and the second electrode to form a second bipolar electrode pair, it fails to disclose that the third electrode is common at all. Notwithstanding the foregoing, it should be appreciated that the mere use of a third electrode as a common electrode to two other electrodes does not necessarily create two bipolar electrodes pairs, as required by the claims. For example, a third electrode can be common to two electrodes to form a single tripolar electrode pair.

Independent claim 37 requires the conveyance of ablation energy between the two electrode elements and the other electrode element to create two ablation regions that, in composite, form a three dimensional lesion within the diseased region. There is simply no disclosure in Mahvi that the electrode elements 22a-2c are operated in the manner that creates two ablation regions that, in composite, for a three-dimensional lesion.

With respect to the obviousness rejection, the Examiner stated that "it would have been obvious to the skilled artisan to render the middle electrode as the common electrode since the reference clearly teaches larger lesion volumes are desired and such connection would inherently accomplish the same." Again, the fact that Mahvi discloses the problem to be solved by the claim invention—i.e., creating larger lesion volumes, does not mean that every solution to that problem would be obvious, including the solution solved by the claimed invention. There is nothing in Mahvi that suggests to one of ordinary skill in the art that the middle electrode array be configured as common electrode to two separate bipolar electrode pairs. The Examiner also stated that the claimed combination has a predictable result. However, the claimed invention does not have a predictable result.

Again, as stated above, the present inventions require more than the mere use of a third electrode as a common electrode. The present inventions require the common electrode to be common to two bipolar electrode pairs. As stated in the previous response, the claimed invention uses a common electrode element between two electrode elements to create two bipolar electrode arrangements, each of which is more closely spaced than if electrical energy were to be conveyed between the two electrode elements. That is, by adding an electrode element, the distance that the electrical energy needs to travel from each of the two electrode elements to the common electrode element will be equal to one-

half the spacing between the two electrode elements, thereby effectively cutting the distance that the electrical energy has to travel between electrode elements in half. (See page 15, line 21 to page 16, line 3 of the specification). As a result, the ablation process is made more efficient. (See page 21, lines 15-20).

Notwithstanding the foregoing, it should also be appreciated that the mere fact that a claimed combination has a predictable result is not the test for determining whether the claimed combination is obvious. As made clear in KSR, a claimed combination that has a predictable result may be obvious if the modified feature is a design choice. As stated above, the modification of the one of the electrode elements 22a-22c of Mahvi to serve as a common electrode that interacts with the other two of the electrode elements 22a-22c to create two bipolar electrode pairs is not a design choice.

Thus, Applicant submits that claims 1-5, 7, 9-13, 15-17, 23, 25-30, 32, 34-39, and 41-46 are not anticipated or obvious over Mahvi, and as such, respectfully request withdrawal of the §102, 103 rejections of these claims.

#### Allowable Subject Matter

Applicant graciously acknowledges the Examiner's indication that claim 19 recites patentable subject matter. In accordance with the Examiner's suggestion, the limitations of claim 19 and the intervening claim 14 have been incorporated into independent claim 10, as discussed above.

#### Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments

Attorney Docket No.:  
03-0255 (US01)

regarding this amendment, the Examiner is respectfully requested to contact the  
undersigned at (949) 724-1849.

Respectfully submitted,

**VISTA IP LAW GROUP LLP**

Dated: February 6, 2008

By:



Michael J. Bolan  
Reg. No. 42,339

Customer No. 23410  
Vista IP Law Group LLP  
2040 Main Street, 9<sup>th</sup> Floor  
Irvine, CA 92614